



03560.002791.

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
KEISHI DANJO ET AL. ) : Examiner: A. Patel  
 ) : Group Art Unit: 2879  
 )  
Application No.: 09/846,555 :  
 )  
Filed: April 30, 2001 :  
 )  
For: SUBSTRATE FOR FORMING AN :  
ELECTRON SOURCE, ELECTRON :  
SOURCE, AND IMAGE DISPLAY :  
DEVICE ) : October 29, 2004

Mail Stop  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT  
AND (CONDITIONAL) PETITION UNDER 37 C.F.R. § 1.181

Sir:

This paper is filed in response to the Office Action dated October 1, 2004, which required a restriction between the following allegedly patentably distinct groups of claims:

1. Group I, Claims 5, 6, and 8-27, drawn to a precursor, classified in class 428, subclass 447;
2. Group II, Claims 28-30, drawn to an electron source, classified in class 250, subclass 492.3; and

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III. Group III, Claims 31-34, drawn to an image display device, classified in class 313, subclass 495.

Applicants provisionally elect to proceed with examination of Group II (Claims 28-30), subject to the below traversal.

The Office Action describes how the Examiner believes the following groups are related to each other: Groups II and I, and Groups III and I. In view of the Office Action, the Examiner apparently believes that the Group I claims are a subcombination of both the Group II and Group III claims.

However, the Office Action does not explain how the Examiner believes Groups II and III relate to each other, nor does it explain why a restriction between those Groups is required and justified. Because no such explanation is given, it is believed that at least the restriction requirement between Groups II and III is improper, and its withdrawal is therefore respectfully requested.

Moreover, Applicants believe that the Examiner has mis-applied the test for determining whether there is a combination and subcombination which would justify a restriction between the Group I and II claims, and between the Group I and III claims. The proper test is whether the combination requires the particulars of the subcombination for patentability, and whether the subcombination has utility by itself or in other combinations (MPEP §806.05(c)). Thus, to support a restriction based on an alleged combination and subcombination, an examiner must show, among other things, that the combination is

patentable over the prior art even without the particulars of the subcombination. It is respectfully submitted that the Office Action has not sufficiently presented such a showing. Indeed, with regard to application of the first part of the test to Groups I and II, the Office Action states merely that:

“the combination [i.e., apparently the Group II claims] as claimed does not require the particulars of the subcombination [i.e., apparently the Group I claims] as claimed because the electron source does not require the metal oxide of either particular as recited in claim 8 or 25, or electrically conductive as recited in claim 9 or 16 or 26 or selected from a group consisting of Fe, Ni, Cu, Pd, Ir, In, Sn, Sb and Re, as recited in claim 10, 17 or 27.”

Also, with regard to application of the first part of the test to Groups I and III, the Office Action states merely that:

“the combination as claimed [i.e., apparently the Group III claims] does not require the particulars of the subcombination [i.e., apparently the Group I claims] as claimed because the image display device does not require the metal oxide of either particular as recited in claim 8 or 25, or electrically conductive as recited in claim 9 or 16 or 26 or selected from a group consisting of Fe, Ni, Cu, Pd, Ir, In, Sn, Sb and Re, as recited in claim 10, 17 or 27.”

The foregoing statements are not seen to explain how the Group II and III (combination) claims, which each depend from Group I (subcombination) claims, can be patentable over the prior art without the particulars of the Group I claims. Therefore, it is believed that the Office Action has failed to establish a proper justification for the three-way restriction requirement, and withdrawal of the restriction requirement is therefore respectfully requested.

If the Examiner is not persuaded to remove the restriction requirement in view of the foregoing remarks, he is respectfully requested to explain why he believes that the Group II and III claims each do not require the particulars of the Group I claims *for patentability* (i.e., how the Group II and III claims could be patentable over the prior art without the particulars of the Group I claims), and why he believes a restriction between the Group II and III claims is justified. Also if the Examiner is not persuaded to withdraw the restriction requirement in view of the above remarks, this paper should be treated as a Petition to invoke the supervisory authority of the Commissioner under 37 C.F.R. § 1.181, and should be forwarded with the filewrapper to the appropriate Patent and Trademark Office official for reconsideration of the restriction requirement in view of the above remarks.

Although no fee is believed due in connection with this Petition in view of the apparently improper restriction requirement issued by the Patent and Trademark Office, any fee that may be deemed required may be charged to Deposit Account No. 06-1205.

Applicants respectfully request favorable reconsideration and an early and favorable action on the merits of all presently pending claims.

Applicants' undersigned attorney may be reached in our New York office by

telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,



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